

BUR9-2003-0148-US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATIONRECEIVED
CENTRAL FAX CENTER

In Re: Paul A. Manfredi
Serial No.: 10/709,574
Filed: May 14, 2004
Title: **APPARATUS AND METHOD
FOR CLEANING ELECTRONIC
ARTICLES**

Atty. Docket: BUR9-2003-0148-US1 MAY 18 2004
Today's Date: May 14, 2004
Group Art Unit: (not assigned)
Examiner: (not assigned)
Fax: 703-872-9306

OFFICIAL

PETITION PURSUANT TO 37 C.F.R. § 1.47(b)

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This petition is being filed pursuant to 37 C.F.R. 1.47(b) involving a filing where the sole inventor refuses to execute an application for patent. Mr. Paul A. Manfredi has refused to execute an application for patent in the above-identified application after diligent efforts were made to have Mr. Manfredi execute the declaration and assignment documents.

At the time of invention, Mr. Manfredi was an employee of International Business Machines Corporation (IBM). Mr. Manfredi agreed in writing to assign to IBM all inventions made during his employment with IBM. A copy of Mr. Manfredi's employment agreement is provided in Exhibit A. As stated in Mr. Manfredi's employment agreement, he agrees to assign his rights to the invention and to cooperate with IBM in the execution of the documents relating to the acquisition of patent rights. Pertinent sections of Mr. Manfredi's employment agreement are shown below:

"4. I hereby assign to IBM my entire right, title and interest in any invention or idea, patentable or not, hereafter made or conceived solely or jointly by me: ..." , and

"5. b. I will, on his [IBM Patent Operations Manager] request, promptly execute a specific assignment of title to IBM, and do anything else reasonably necessary to enable IBM to secure a patent therefor in the United States and in foreign countries."

I had firsthand knowledge of the facts that the invention was made by Mr. Manfredi while employed by IBM. I was in attendance at a meeting in June 2003 which was also attended by Mr. Manfredi. At the meeting, Mr. Manfredi described the invention which he had documented in disclosure BUR8-2003-0101 (see Exhibit B). Mr. Manfredi was an employee of IBM at the time of the meeting in June 2003. Mr. Manfredi created disclosure document BUR8-2003-0101 on March 17, 2003 prior to the June 2003 meeting. The presentation by Mr. Manfredi at the meeting in June 2003 and the disclosure document BUR8-2003-0101 show that Mr. Manfredi was an employee of IBM at the time of invention and disclosed the invention to IBM. Therefore, Mr. Manfredi was an employee of IBM at the time of invention and agreed in writing to assign the invention to IBM.

The facts relating to this refusal are set forth as follows.

Based on my conversations with Carol Mueller, my office assistant, Ms. Mueller communicated to me that she made multiple telephone calls and left telephone messages for Mr. Manfredi at his home requesting his cooperation in the review of attorney docket number BUR9-2003-0148-US1. Ms. Mueller told me that she received no response to her telephone messages from Mr. Manfredi. On November 21, 2003 and November 26, 2003, I left telephone messages for Mr. Manfredi at his home requesting his cooperation in the review of BUR9-2003-0148-US1. I received no response to my telephone messages from Mr. Manfredi. The application papers including a cover letter (see Exhibit C), a copy of the patent application including drawings, and the declaration and assignment documents were U.S. Postal Service (USPS) Express Mailed to Mr. Manfredi's home address and were received on December 12, 2003 as indicated by the USPS Receipt (see Exhibit D). It was requested in the cover letter that the

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application papers be returned to my office by December 23, 2003.

As stated in the cover letter (see Exhibit C), IBM made a reasonable offer of \$500 to more than compensate Mr. Manfredi for his time and effort to review and sign the application papers. Mr. Manfredi's response to IBM's request was an email to me on December 23, 2003 in which Mr. Manfredi requested financial compensation in the amount of \$10,000 in return for reading and signing the application papers (see Exhibit E). In another email to me on March 17, 2004 (see Exhibit F; last paragraph), Mr. Manfredi increased the amount of his requested financial compensation to \$15,000.

IBM believes that it made more than a reasonable offer of compensation for a reasonable amount of work that would have been required of Mr. Manfredi to fulfill his obligations under his employment agreement. The fact that Mr. Manfredi requested a significantly higher amount of compensation and then increased the amount he was requesting in return for his cooperation indicated to me that Mr. Manfredi was not willing to cooperate with IBM as per the terms of his employment agreement.

IBM believes that it should be allowed to make application for patent on behalf of and as agent for Mr. Manfredi. Such action is necessary to preserve the rights of IBM since the invention is in the field of electronics and IBM is a major manufacturer of electronic products. IBM has a major licensing program which relies on patent protection for its inventions. IBM's licensing program generates income for IBM and provides freedom of action for IBM in business areas that IBM engages in. The field of electronics is a competitive area where new development is occurring by competitors and, as such, IBM needs to file the above-identified application to protect its intellectual property and remain competitive.

The application papers in the above-identified application have been signed by Lynne D. Anderson, who is authorized to approve and execute documents on behalf of IBM relating to proceedings in the United States Patent and Trademark Office by Gerald Rosenthal, Vice

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President, Intellectual Property and Licensing of IBM. A copy of Mr. Rosenthal's "Letter of Authority" delegating authority to Ms. Anderson is included with the application papers and a copy is provided in Exhibit G.

The last known address of Mr. Manfredi is the following:

382 Twin Peaks Road
Waterbury Center, VT 05677

Therefore, it is respectfully requested that this petition be granted to allow IBM to make application for patent on behalf of and as agent for Mr. Manfredi in the above-identified application under the provisions of 37 C.F.R. 1.47(b).

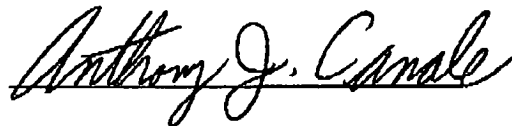
Please charge the petition fee of \$130 to Applicants' Deposit Account, 09-0456.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully Submitted,

By:



Anthony J. Canale
Registration No. 51,526
Agent for Applicant
Phone: (802) 769-8782
Fax: (802) 769-8938
Email: acanale@us.ibm.com

IBM Corporation
Intellectual Property Law - Zip 972E
1000 River Street
Essex Junction, Vermont 05452

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EXHIBIT A

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IBM**Employee Confidential Information and Invention Agreement***(To be signed by all employees on the first day of employment)*

In consideration of my employment by IBM:

1. I will not disclose to anyone outside of IBM, or use in other than IBM's business, any confidential information or material relating to the business of IBM or its subsidiaries, either during or after my IBM employment, except with IBM's written permission. I also understand that information and materials received in confidence from third parties by IBM and its subsidiaries is included within the meaning of this paragraph.
2. I will not disclose to IBM, or induce IBM to use, any confidential information or material belonging to others.
3. I will comply, and do all things necessary for IBM to comply, with United States Government regulations, and with provisions of contracts between the agencies of the United States Government or their contractors and IBM, which relate either to patent rights or to the safeguarding of information pertaining to the defense of the United States.
4. I hereby assign to IBM my entire right, title and interest in any invention or idea, patentable or not, hereafter made or conceived solely or jointly by me:
 - a. while working in IBM in an executive, managerial, planning, technical, research or engineering capacity (including development, manufacturing, systems, applied science, sales and customer engineering); and
 - b. which relates in any manner to the actual or anticipated business of IBM or its subsidiaries, or relates to its actual or anticipated research and development, or is suggested by or results from any task assigned to me or work performed by me for or on behalf of IBM;
 except any invention or idea which I cannot assign to IBM because of a prior invention agreement with

which is effective until

None*(Give name and date or write "none").*

5. I agree that in connection with any invention or idea covered by paragraph 4:
 - a. I will disclose it promptly to the local IBM Patent Operations Manager; and
 - b. I will, on his request, promptly execute a specific assignment of title to IBM, and do anything else reasonably necessary to enable IBM to secure a patent therefor in the United States and in foreign countries.
6. I represent that I have indicated on the back of this form any inventions or ideas, not covered by Paragraph 4, in which I have any right, title or interest, and which were previously conceived either wholly or in part by me, but neither published nor filed in the United States Patent Office, and identified all of these.

If you do not have any inventions or ideas to indicate, write "none" on this line: None

(It is in your interest to establish that any such inventions or ideas were made before employment by IBM. You should not disclose such inventions or ideas in detail, but only identify them by the titles and dates of documents describing them. If you wish to interest IBM in such inventions and ideas, you may submit them to IBM in accordance with the provisions outlined in IBM's Form MO5-4472.)

7. I acknowledge receipt of a copy of this agreement, and agree that with respect to the subject matter hereof, it is my entire agreement with IBM, superseding any previous oral or written communications, representations, understandings, or agreements with IBM or any official or representative thereof.

Witness:

R. A. Lanni
 Employee's Manager or other
 appropriate IBM representative

Signed:

Paul A. Manfredi
 Employee's Full Name

Date:

11/16/73

Date:

Nov. 16, 1973

Personnel Folder

(over)

MO5-2097-2

(If you have entered "none" in Paragraph 6, do not fill in this section.)

The following are inventions or ideas, not covered by Paragraph 4, in which I have any right, title or interest, and which were previously conceived either wholly or in part by me, but neither published nor filed in the United States Patent Office:

Description of Documents: (If applicable)

Title on Document	Date on Document	Name of Witness on Document
_____	_____	_____
_____	_____	_____
_____	_____	_____
_____	_____	_____

Signed: _____
Employee's Full Name

Date: _____

EXHIBIT B

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**Disclosure BUR8-2003-0101**

Prepared for and/or by an IBM Attorney - IBM Confidential

Created By Paul Manfredi On 03/17/2003 09:07:06 AM MST

Last Modified By Patricia L Blair On 08/20/2003 10:44:58 AM EDT

Required fields are marked with the asterisk (*) and must be filled in to complete the form .

***Title of disclosure (in English)**

Grounded Brush Clean

Summary

Status	Final Decision (File)
Final Deadline	
Final Deadline Reason	
Docket Family	BUR8-2003-0148
*Processing Location	Burlington
*Functional Area	select (Burlington - MD) All Inventors Located in Burlington
Attorney/Patent Professional	Anthony Canale/Burlington/IBM
IDT Team	select Scott Cummings/Burlington/IBM
Submitted Date	03/17/2003 09:38:02 AM MST
*Owning Division	select MD
Incentive Program	
Lab	Rozich
*Technology Code	1102
PVT Score	25

Inventors with a Blue Pages entry

Inventors: Paul Manfredi/Burlington/IBM

Inventor Name	Inventor Serial	Div/Dept	Inventor Phone	Manager Name
> Manfredi, Paul A.	060262	29/AYUV	448-1128	Pakulski, Steven F.

> denotes primary contact

Inventors without a Blue Pages entry**IDT Selection**

Attorney/Patent Professional Anthony Canale/Burlington/IBM
 IDT Team Scott Cummings/Burlington/IBM
 Response Due to IP&L 05/17/2003

***Main Idea**

Main Idea for disclosure - continued

**Main Idea for Disclosure BUR8-2003-0101**

Prepared for and/or by an IBM Attorney - IBM Confidential

Archived On 06/18/2003 01:03:59 AM

Title of disclosure (In English)

Grounded Brush Clean

Main Idea of disclosure

1. Background: What is the problem solved by your invention? Describe known solutions to this problem (if any). What are the drawbacks of such known solutions, or why is an additional solution required? Cite any relevant technical documents or references.

The buildup of static electricity charge on the devices is damaging our product. This problem and exposure is current and has manifested itself with devastating result to our 300 MM fab in Fishkill NY. We may also be encountering this problem on our 200 MM clean stations but has yet to be identified as a Yield Detractor in BTU.

2. Summary of Invention: Briefly describe the core idea of your invention (saving the details for questions #3 below). Describe the advantage(s) of using your invention instead of the known solutions described above.

By utilizing a brush made of conductive material, carbon filled PFA, or supplying a leading / trailing edge flexible conductor that maintains a ground with the isolated devices during the cleaning process static charges can be eliminated.

3. Description: Describe how your invention works, and how it could be implemented, using text, diagrams and flow charts as appropriate.

If a carbon filled PFA sponge or other suitable conductive material were used during the cleaning cycle, static charge would be eliminated. This would be accomplished by maintaining ground, of each device, when the brush is in contact, during the cleaning process.

EXHIBIT C

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International Business Machines Corporation

Microelectronics Division
Intellectual Property Law
Mail 972E
1000 River Street
Essex Junction, VT 05452
Phone - 802 769-8782
Fax - 802 768-8938
E-mail - acanale@us.ibm.com

December 8, 2003

Mr. Paul Manfredi
382 Twin Peaks Road
Waterbury Center, VT 05677

Re: BUR920030148US1

Dear Mr. Manfredi:

Please find enclosed patent application BUR920030148US1 and associated formal papers. I am requesting that you review the patent application and sign the associated formal papers. As stated in my telephone messages to you on November 21, 2003 and November 26, 2003, should you sign the formal papers, the application will be filed with the United States Patent Office and you will receive an IBM Patent Award in the amount of \$500.00 for the filing of the application. The award will be processed by your former manager, Steven Pakulski. If you do not sign the formal papers, the application will be filed without your signature and you will not receive any financial award related to the filing of this application.


Should you sign the formal papers, we would require that they be returned to our office in the enclosed, pre-paid return envelope by Tuesday, December 23, 2003.

Sincerely,

Anthony J. Canale
Patent Agent

EXHIBIT D

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SENDER: COMPLETE THIS SECTION		COMPLETE THIS SECTION ON DELIVERY	
<ul style="list-style-type: none">■ Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.■ Print your name and address on the reverse so that we can return the card to you.■ Attach this card to the back of the mailpiece, or on the front if space permits.		A. Signature 	
1. Article Addressed to: PAUL MANFREDI 382 TWIN PEAKS RD. WATERBURY CENTER, VT 05677		B. Received by (Printed Name) C. Date of Delivery 7/21/03	
2. Article Number EV 024 700 890 US (Transfer from service label)		D. Is delivery address different from item 1? <input type="checkbox"/> Yes If YES, enter delivery address below: <input type="checkbox"/> No	
3. Service Type <input type="checkbox"/> Certified Mail <input checked="" type="checkbox"/> Express Mail <input type="checkbox"/> Registered <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.		4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes	

PS Form 3811, August 2001 Domestic Return Receipt 102595-02-44-1035

EXHIBIT E

BUR9-2003-0148-USI



Paul Manfredi
<myviperis1@yahoo.com>
12/23/2003 10:22 AM
This document expires on
12/23/2005

To Anthony Canale/Burlington/IBM@IBMUS
cc
bcc
Subject Patent Review and applications.

Dear Mr.Canale:

As a former employee of IBM I am not obligated to review any of the patent applications I will however do so for the sum \$10,000.00 each. I am open to offers regardin my signiture.

If you have any question regarding this matter I can be reached at802-244-6933.

Paul A. Manfredi

Do you Yahoo!?

Protect your identity with Yahoo! Mail AddressGuard

EXHIBIT F

BUR9-2003-0148-US1



Paul Manfredi
<myviperis1@yahoo.com>
03/17/2004 01:27 PM

To Anthony Canale/Burlington/IBM@IBMUS
cc
Subject Re: Patent Review and applications.

Anthony, attached are the tough business decisions IBM and My company face now and in the foreseeable future.

IBM's Position:

As you know times are tough in the semiconductor industry. Although you have worked for many years for the promises made and you years of service have been greatly appreciated it is necessary for IBM to set a new standard of rules IBM does not take these steps lightly. However if we are going to survive in today's market place we need to make tough decisions

We as a company are now going to change the rules governing medical, retirement, and employment or whatever we need to do. The prior 20 years of service you have provided up until 1993 while accepting a lower salary the promise of a life long job as long as your performance is good and free medical coverage is no longer in effect. Regardless of your abilities, if you are caught up in a reorganization and the job requirements change we will need to let you go. If and when business needs dictate and additional manpower is needed, you will not be considered.

My Company:

For twenty years you work hard and provide your employer undivided attention. You come in whenever called for emergencies, work holidays and rotational shifts. You put the needs of your employer first. You do all this for the promised benefits. You plan your future years based on the circumstances presented by your employer. You trust that what Management has said to you at every appraisal will be honored. Management agrees that your salary is low however they point out the cost of benefits they provide for free and while other company's are laying off IBM maintains its full employment policy. You accept this and plan for your future years accordingly. Some twenty years later you are locked in trying to reach your goals for a decent retirement. During this twenty year phase you have never received an appraisal lower than a two in any of your career/job assignments. In total years of service you have received 23 two rating appraisals and six one appraisals. You are told you are valued for your performance and significant contributions to IBM. Your suggestions, ideas and patents contribute to leading edge technologies, generating huge manufacturing revenue. You do your best to provide IBM with IP

so they can be the leader in patent submissions within the industry. You are told you are a prolific inventor and your contributions to the company appreciated.

Twenty years later the future you have worked so hard to build gets pulled out from under you. Full employment becomes a thing of the past. To avoid getting let go you relocate to Vermont. You take on a new assignment in equipment engineering and become a leader in tooling and process development technology. Your free medical benefits are now costing you the price of a car payment and increase every year with no end in sight. You are offered a new cash balance plan for your retirement at a price that will only last you at most five years. Due to Federal law if you are over forty you can stay under the old plan however you will not receive any additional pension credit for the additional years of service past 1992. You still accept this. Now years later you get caught up in a reorganization and one month before you reach retirement eligibility you are let go. No offer is made to take on a new assignment within IBM, just "Do to ! business needs we are no longer needing your services". Three months after you are let go IBM starts hiring new employees to do the job you were doing without any consideration to past employees that had provided dedicated service.

I reach retirement through the "Bridge" and get hit with a 100% increase in medical cost over an active employees rate which had just increase 100% in 2004.

My company consists of my family members and as the CEO of this company I do not work for free. I was legally obligated to review and sign the three patent applications while employed by IBM. As of December 1, 2003 I was no longer a IBM employee. As you know times have changed just as they have for IBM I am obligated to my stock holders. I am to provide the necessary funds to sustain and reasonable life style. Due to the needs of my business it is just as important that my stock holders are happy with my performance as CEO, this is the same as it is to IBM's stockholders.

During the final two months of employment, while I looked for a job in Vermont, IBM had the opportunity to close on any open issues regarding my IBM employment. During this time period I was obligated to perform reasonable duties and cooperate as necessary. As you know nothing was presented to me during this time period. As of November 17, 2003 I no longer received compensation from IBM and was considered no longer an employee. As of November 31, 2003 I was fully retired through the "Bridge". Any and all agreements made with IBM other than disclosing confidential material to others outside of IBM became null and void.

Due to business needs my company will require payment in the form of US currency for each of the patent reviews and assignment to IBM as you have been requesting. The charge for the technical review is \$ 2500.00 each. The charge for transferring the patent rights over to IBM is \$12,500.00 each. This offer is good for a period of thirty days from receipt.

If you have any questions regarding this matter I can be reached by calling at 802-244-6933.

Sincerely :

Paul A. Manfredi

President ,CEO, and Treasure ot the Manfredi Family

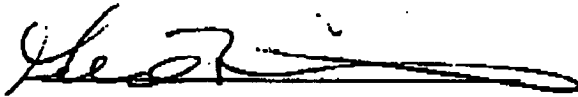
EXHIBIT G

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LETTER OF AUTHORITY

I, Gerald Rosenthal, Vice President, Intellectual Property and Licensing of International Business Machines Corporation (IBM), a New York corporation, do hereby delegate the authority to approve and execute documents on behalf of IBM relating to proceedings in the Patent, Trademark Registration or Copyright Offices servicing any country or region of the world, or to related appeal proceedings, including, but not limited to: petitions; powers of Attorney; authorizations; verification; nominations of representatives; declarations; documents relating to maintenance and defense of the resulting industrial property rights; assignments of rights to apply for and acquire patents and trademark registrations; and evidence of such assignments; requests for the registration of patents as available for licensing; reports of inventions and petitions for waiver of patent rights to any department or agency of the United States Government; and, assignments, licenses and other instruments confirmatory of Government rights in patents and inventions, to Lynne D. Anderson, Program Manager, Patent Office Liaison.

Date: April 6, 2004



Gerald Rosenthal
Vice President, Intellectual Property & Licensing
International Business Machines Corporation